IN THE

Supreme Court of the United States

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CHARLES ELMORE CROPLEY
CLERK

OCTOBER TERM, 1940.

No. 347

FOOD MACHINERY CORPORATION,

Petitioner,

vs.

FRUIT TREATING CORPORATION, WINTER PARK PACKING COMPANY, McDONALD CORPORATION, UMATILLA FRUIT COMPANY, and L. E. HOLLOWAY, TRADING AS L. E. HOLLOWAY & COMPANY,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FIFTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE FIFTH CIRCUIT.

To: The Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your Petitioner, FOOD MACHINERY CORPORATION, respectfully prays for a Writ of Certiorari to the Circuit Court of Appeals for the Fifth Circuit to review a judgment of that Court entered May 27, 1940.*

*See Certified Copy at the end of the printed transcript of Record.

Summary and Short Statement of the Matter Involved.

This is a suit for infringement of a patent on a process of treating fruit. The patent, No. 1,909,860, was granted on May 16, 1933, to petitioner as assignee of the inventor, Dr. Rodney B. Harvey. The District Court for the Southern District of Florida found the patent valid, the patented process novel, and the first to provide a commercially successful method of enhancing the natural varietal color of the skin or peel of fresh citrus fruits by impregnating the latter to impart a uniform added color; that the patented process had utility and had gone into widespread commercial use, being employed on a large part of all of the oranges packed in the State of Florida, and had substantially increased the price at which said fruit was sold [*R. 673, Findings of Fact, 2, 3]. Judgment was entered accordingly for an injunction and recovery of profits and damages [R. 676-677].

The patented invention is the first discovery of a process by which the color of pale or yellow oranges may be enhanced to their true varietal orange-red color without injury to the fruit and without departing from the natural appearance of the fruit. Poorly colored oranges suffer a severe penalty when sold in competition with better colored oranges. A deficiency in color is no indication of any inferiority in the quality of the fruit and paler fruit may be as good or better than fruit of higher color. The Federal Department of Agriculture has for many years

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[*References to the printed transcript of record are herein referred to by the abbreviation "R." followed by the page number.]

encouraged and conducted experimental work to improve the appearance of citrus fruit. Approximately twenty years ago it introduced the ethylene bleaching process for removing any green chlorophyl that might otherwise mar the appearance of the fruit and most of the oranges produced in this country are treated by that process. The ethylene process will not deepen the color of pale fruit.

Owing to climatic or soil conditions most of the oranges produced in Florida and Texas are inferior in color compared with oranges produced in other localities and particularly California. After treatment with the ethylene process Florida and Texas oranges are a pale yellow compared to the more brilliant orange-red color of California oranges. In the markets the paler fruit is severely penalized because of its inferiority in color. The difficulties and penalties imposed on Florida and Texas oranges when sold in competition with higher colored fruit such as that from California has long been a matter of serious concern to the citrus producers of Florida and Texas. As the production of oranges increased in Florida the situation became acute and the color of Florida oranges was a matter of legislative and industry concern in Florida as early as the season of 1927-28. Prior to the introduction of the patented Color Added Process great difficulty was experienced in the marketing of Texas oranges in competition with the higher colored California oranges.

The process was introduced in Florida by appellee, Food Machinery Corporation, during the season of 1935-36 and this was followed shortly by the introduction of the process

in Texas. The process was immediately widely adopted by the citrus industries of both states and has since been used to enhance the color of most of the oranges marketed from those states. Substantially all of the packers of citrus fruit in the states of Florida and Texas are licensed by appellee and have acknowledged the validity of the patent in suit. Laws have been enacted by the legislatures of both the States of Florida and Texas to govern and regulate the use of the process and to prevent the process being abused by use on fruit of inferior quality. The process has served to substantially increase the returns from their orange crops to the citrus growers of the states of Florida and Texas. The patent in suit is the first to teach how to successfully apply an oil-soluble approved food dye to enhance their varietal color. This is something that had never been accomplished before Dr. Harvey's discovery.

Oranges are only produced in the Fifth and Ninth Circuits. The Harvey process is not used in the Ninth Circuit, as California and Arizona Oranges naturally have a bright orange-red varietal color. The process has been used in Florida and Texas in the Fifth Circuit. There is, therefore, substantially no chance that the process will ever go into use elsewhere than in the Fifth Circuit or that the validity of the Harvey patent will be adjudged in any other Circuit.

The defenses alleged in respondent's answer [R. 48-55] were the usual ones of want of invention, anticipation,

want of patentable novelty, prior invention by others, public use by others, and non-infringement.

The Court of Appeals, *sua sponte,* without even hearing argument on such defense, it not being mentioned in the briefs, and without any evidence on the question, declared the patent invalid, saying:—

> *"Since each of the three claims in question depends for its validity upon the sufficiency of the disclosures of the patent, the defect mentioned is the spoilation of all, and the bill of complaint should have been dismissed."* [Opinion C.C.A. found at end of printed record.]

No defense was alleged, as required under R.S.U.S. §4920—35 USCA §69 (*Providence Rubber Co. v. Goodyear Rubber Co.,* 76 U.S. 788; *Jennings v. Pierce,* Fed. Cas. 7283; *M. Swift & Son v. W. H. Coe Mfg. Co.,* 102 Fed. (2d) 391 at 393, C.C.A. 1; *Kansas City So. Ry. Co. v. Silica Products Co.,* 48 F. (2d) 503, at 507, C.C.A. 8), that the Harvey patent did not describe the process or method in such full, clear, concise and exact terms as to enable one skilled in the art to make and use the same (R.S.U.S. §4888; 35 USCA §33).

This issue was not litigated in the District Court and respondents offered no proof in an attempt to show any insufficiency of the Harvey specification to enable one skilled in the art to make and use the patented method.

The Harvey patent does not purport to cover the broad idea of dyeing oranges, or all processes of dyeing oranges. It was not so expanded or interpreted by the District Court, whose judgment extended no further than to sustain the patent and Claims 1, 3, and 4 thereof as valid as covering the particular process or method specifically set forth at page 3, lines 13-63 thereof [R. 425]. The Harvey patent describes more than one process or method, but this suit was predicated upon the infringement by respondents of the particular method so adjudged novel and infringed. It was not necessary for the District Court to determine whether the patent is valid if extended to any other method. Whether Harvey attempted to cover too much ground is a question that properly should be left until occasion arises for decision of that question. (*Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, at 432; *Faultless Rubber Co. v. Star Rubber Co.*, 202 F. 927, at 931, C.C.A. 6; *Research Products Co. v. Tretolite Co.*, 106 F. (2d) 530, at 534 (C.C.A. 9); *American Stainless Steel Co. v. Ludlum Steel Co.*, 290 F. 103 at 109, C.C.A. 2.)

Reasons Relied Upon for the Granting of a Writ of Certiorari.

The discretionary power of this Court is invoked upon the following grounds:–

1. Because of the concentration in the Fifth Circuit of the industry in which the patented method is used, litigation elsewhere resulting in conflict of decision is improbable. *Schriber-Schroth Co. v. Cleveland Trust Co., et al.,* 305 U.S. 47 at 50; *Mackay Radio & Telegraph Co., Inc. v. Radio Corp. of America,* 306 U.S. 86, at 89; *Paramount Publix Corp. v. American Tri-Ergon Corp.,* 294 U.S. 464; *Altoona Publix Theatres v. American Tri-Ergon Corp.,* 294 U.S. 477.

2. Because the decision of the Court of Appeals is in conflict with the decision of this Court in *The Providence Rubber Co. v. Goodyear,* 76 U.S. 788, and the decisions in *M. Swift & Sons v. W. H. Coe Mfg. Co.,* 102 Fed. (2d) 391, 393, C.C.A. 1; *Kansas City So. Ry. Co. v. Silica Products Co.,* 48 Fed. (2d) 503, 507, C.C.A. 8, and *Jennings v. Pierce,* Fed. Cas. 7283, holding that a defense of insufficiency of a patent specification is an affirmative defense raising an issue of fact, which must be pleaded, and with the decisions of this Court in *Battin v. Taggert,* 17 How. (58 U.S.) 77; *Wood v. Underhill,* 5 How. 1, 46 U.S. 1; *Webster Loom Co. v. Higgins,* 105 U.S. 580; *Hogg v. Emerson,* 52 U.S. 587; *Corn Planter Patent,* 23 Wall. 181; *Woodworth v. Wilson,* 4 How. 712, 716; *Lawler v. Hamilton,* 124 U.S. 1; *Minerals Separation v. Hyde,* 242 U.S. 261, 270, 271; *Eibel Process Co. v. Minnesota & Ont. P. Co.,* 261 U.S. 45, 65, that

even when properly pleaded such a defense presents an issue of fact to be determined on proofs; the grant of the patent is *prima facie* evidence of the sufficiency of the specification and a determination by the Patent Office authorities of this fact; the burden of proving otherwise is upon the defendant. *Chase v. Fillebrown,* 58 Fed. 374, 376.

WHEREFORE, Your Petitioner respectfully prays that a Writ of Certiorari be issued under the seal of this Court, directed to the United States Circuit Court of Appeals for the Fifth Circuit, commanding the said Court to certify and send to this Court on a day to be designated, a full and complete transcript of the record and all proceedings of the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court, that the judgment of the Circuit Court of Appeals be reversed, and that Petitioner be granted such other and further relief as may seem proper.

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